

REMARKS

I. INTRODUCTION

Claims 1-56 are pending and are the subject of this appeal. Claims 1, 38, 48, and 49 are independent claims. Claims 1, 48, and 49 are amended herein. Support for these amendments can be found in paragraphs 151-152 and throughout Applicants' Specification.

In the Examiner's Answer, claims 1-37 and 48-56 were newly rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. Further, prior rejections were maintained in the Examiner's Answer as follows. In the Final Office Action, claims 1, 4-6, 10, 13, 14, 17, 18, 22, 23, 26, 27, 31, 36, and 48 were rejected under 35 USC § 103(a) as allegedly unpatentable over United States Patent No. 7,110,993 ("Soulanille") in view of United States Patent No. 6,801,906 ("Bates"). Claims 2 and 3 were rejected under 35 USC § 103(a) as allegedly unpatentable over the combination of Soulanille and Bates further in view of an article by Weidlich entitled "Search Engine Marketing Revving Up." Claims 7-9, 11, 12, 15, 19, and 37 were rejected under 35 USC § 103(a) as allegedly unpatentable over the combination of Soulanille and Bates further in view of United States Patent Application Publication No. 2003/0177076 ("Might"). Claims 16 and 24 were rejected under 35 USC § 103(a) as allegedly unpatentable over the combination of Soulanille and Bates further in view of United States Patent Application Publication No. 2004/0167845 ("Corn"). Claims 20 and 21 were rejected under 35 USC § 103(a) as allegedly unpatentable over the combination of Soulanille and Bates further in view of United States Patent No. 6,564,208 ("Littlefield"). Claim 25 was rejected under 35 USC § 103(a) as allegedly unpatentable over the combination of Soulanille and Bates further in view of United States Patent Application Publication No. 2006/0190328 ("Singh"). Claims 28 and 29 were rejected under 35 USC § 103(a) as allegedly unpatentable over the combination of Soulanille and Bates further in view of Official Notice. Claim 30 was rejected under 35 USC § 103(a) as allegedly unpatentable over the combination of Soulanille and Bates further in view of United States Patent Application Publication No. 2001/0003177 ("Schena"). Claim 32 was rejected under 35 USC § 103(a) as allegedly unpatentable over the combination of Soulanille and Bates further in view of United States Patent Application Publication No. 2004/0186769 ("Mangold").

Claim 32 was also rejected under 35 USC § 103(a) as allegedly unpatentable over the combination of Soulanille and Bates further in view of United States Patent Application Publication No. 2002/0010015 (“Acres”). Claim 33 was rejected under 35 USC § 103(a) as allegedly unpatentable over the combination of Soulanille and Bates further in view of Mangold and further in view of an article by Mahanta et. al entitled “BT dotcom.” Claim 33 was also rejected under 35 USC § 103(a) as allegedly unpatentable over the combination of Soulanille, Bates, and Acres, further in view of Mahanta. Claims 34 and 35 were rejected under 35 USC § 103(a) as allegedly unpatentable over the combination of Soulanille and Bates further in view of Acres. Claims 38-42 and 44-46 were rejected under 35 USC § 103(a) as allegedly unpatentable over Soulanille and the anonymous article “Google Comes Out Ahead,” and further in view of Bates. Claim 43 was rejected under 35 USC § 103(a) as allegedly unpatentable over Soulanille and the anonymous article “Google Comes Out Ahead,” further in view of Bates, and further in view of Might. Claim 47 was rejected under 35 USC § 103(a) as allegedly unpatentable over Soulanille and the anonymous article “Google Comes Out Ahead,” further in view of Bates, and further in view of Littlefield. Claims 49 and 52-56 were rejected under 35 USC § 103(a) as allegedly unpatentable over Soulanille in view of United States Patent Application Publication No. 2003/0093482 (“Watanabe”) and Bates. Claim 50 was rejected under 35 USC § 103(a) as allegedly unpatentable over Soulanille, Watanabe, and Bates, and further in view of Official Notice. Claim 51 was rejected under 35 USC § 103(a) as allegedly unpatentable over Soulanille, Watanabe, and Bates, and further in view of Might.

In view of the following arguments, all claims are believed to be in condition for allowance over the prior art of record. Therefore, this response is believed to be a complete response to the Office Action. However, Applicant reserves the right to set forth further arguments supporting the patentability of their claims, including the separate patentability of the dependent claims not explicitly addressed herein, in future papers. Further, for any instances in which the Examiner took Official Notice in the Office Action, Applicant expressly does not acquiesce to the taking of Official Notice, and respectfully requests that

the Examiner provide an affidavit to support the Official Notice taken in the next Office Action, as required by 37 CFR 1.104(d)(2).

II. SECTION 101 REJECTIONS

Independent claims 1, 48, and 49, and the claims depending respectively therefrom, are newly rejected under Section 101. Applicants respectfully submit that the foregoing amendments to claims 1, 48, and 49 cause each of these claims to recite patentable subject matter under the machine-or-transformation test of In Re Bilski, 545 F.3d. 943, 88 USPQ2d 1385 (Fed. Cir. 2008).

In amending their claims, Applicants have made note of the “Interim Examination Instructions For Evaluating Subject Matter Eligibility Under 35 U.S.C. § 101” dated August 24, 2009 (“Interim Instructions”). Applicants understand that the Interim Instructions do not have the force of law. However, Applicants further understand that the procedure for determining subject matter eligibility set forth in the Interim Instructions is believed by the Office to comport with the machine-or-transformation test of Bilski. Therefore, because Applicants’ claims now satisfy the criteria set forth in the Interim Instructions, the Examiner should withdraw the present Section 101 rejections.

For example, claim 1 recites a “system,” and now further recites that the system comprises “one or more computer servers configured to provide” various elements. Thus, claim 1 now clearly satisfies the “machine” prong of the machine-or-transformation test. Further, the claim does not “wholly embrace a judicially recognized exception” to patentable subject matter. (See Interim Instructions, page 2.) Assuming *arguendo* that the claim falls within a judicially recognized exception at all, because the claim is tied to a particular set of computer servers having practical limitations, “the claim recites structural limitations for it to qualify as a practical application of the judicial exception.” (*Id.*, page 7.) As the Interim Instructions explain, “a computer programmed with executable instructions is typically construed as a base structure combined with functional descriptive material that could create a patentable distinction over the prior art.” (*Id.*, page 4.) Applicants respectfully submit that claim 1, as amended, falls within the foregoing definition, and therefore does not recite

judicially excepted subject matter. Therefore, claim 1, and all claims depending therefrom, recite patentable subject matter under Section 101.

Like claim 1, claim 48 recites a “system,” and now further recites that the system comprises “one or more computer servers configured to provide” various elements. Therefore, claim 48 recites patentable subject matter under Section 101 for reasons similar to those set forth above concerning claim 1.

Claim 49 recites a “method,” and now further recites that each of the method steps are implemented on a computer server. Therefore, claim 49, like claims 1 and 48, now clearly meets the “machine” prong of the machine-or-transformation test. Further, the recited computer server “implements the process, and [is] not merely . . . an object upon which the process operates.” (*Id.*, page 5.) That is, the recited machine is not merely present in a field of use limitation but imposes a meaningful limitation on the claim’s scope, and its use “involves more than insignificant extra-solution activity.” (*Id.*, Page 8.) Therefore, claim 49, and all claims depending therefrom, recite patentable subject matter under Section 101.

In sum, for at least the foregoing reasons, the new Section 101 rejections of claims 1-37 and 48-56 should be withdrawn.

III. SECTION 103 REJECTIONS

Applicants have presented complete arguments traversing the pending Section 103 rejections of their claims in the prior papers, e.g., Applicants’ Supplemental Appeal Brief dated January 26, 2009, which arguments are fully incorporated herein by reference in their entirety. The Examiner is respectfully requested to reconsider these arguments, and to withdraw the present Section 103 rejections.

CONCLUSION

All rejections have been addressed. In view of the above, the presently pending claims are believed to be in condition for allowance. Accordingly, reconsideration and allowance are respectfully requested and the Examiner is respectfully requested to pass this application to issue. It is believed that any fees associated with the filing of this paper are identified in an accompanying transmittal. However, if any additional fees are required, they may be charged to Deposit Account 18-0013, under order number 66703-0014. To the extent necessary, a petition for extension of time under 37 C.F.R. 1.136(a) is hereby made, the fee for which should be charged against the aforementioned account.

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Respectfully submitted,

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